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Stephen C. Kaufman			JARRETT, SCOTT L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/620,632	Applicant(s) HENN ET AL.
	Examiner SCOTT L. JARRETT	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 December 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14-23,34-37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14-23,34-37 and 39-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/06)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

37 CFR § 1.105 - Requirement for Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Examiner's research indicates that the applicant and/or assignee may have provided a system or method comprising a single interface/screen (e.g. portal) to both workflow and collaboration systems more than one year prior to the earliest effective filing date of the instant application as evidenced by at least the following publicly available references (attached below):

- Lotus Launches Hosted Web Collaboration Services For Customers and Business Partners (2001) teaches a system and method comprising in the same screen an interface to both workflow and collaboration systems as well as a list of workflow participants that the user may collaborate with. More specifically the article teaches "*Lotus Collaboration Services consists of the following: A hosted, single, integrated solution based on Lotus Sametime and QuickPlace, to provide secure instant messaging, e-meetings and virtual workspace capabilities. Key elements are: Lotus Collaboration Services Home Page -- A three-panned, customer- branded home page that will allow users to launch or install their "Buddy" list, see and attend the online meetings that have been scheduled and access their*

QuickPlace workspace. The home page also includes a searchable directory which indicates which members are online and available for conversation. Lotus Collaboration Services Connect Client -- The Connect client helps users determine the online status of their colleagues or "buddies" and is used to begin instant messaging sessions. Lotus Collaboration Services Meetings -- The Meetings page displays active and scheduled meetings and serves as a launch point to attend or to schedule new e-meetings. Lotus Collaboration Services Workspaces -- The Workspaces page is used for instant Web-based team collaboration, providing centralized, self-service workspaces to distributed teams and communities over the Internet.", (emphasis added, Paragraphs 10-15, Page 2).

- New collaboration capabilities for WebSphere Portal Extend 4.2 (2002) - Pages 1, Last 5, Bullets Page 1; Figures on Pages 6, 16-18.
- LaMonica, IBM makes Websphere connection (2003) – Paragraphs 2, 5 discussing Collaboration Center.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter, specifically information on the process/methods utilized by the above-cited products and/or services provided by the applicant and/or assignee.

In response to this requirement, please state the specific improvements of the claimed subject matter in claims 14-23, 34-37, 39-47 over the method or system for providing a screen/interface for accessing both collaboration and workflow systems disclosed above and indicate the specific elements in the claimed subject matter that provide those improvements.

In response to this requirement, please provide the citation and a copy of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of providing a screen/interface for accessing both collaboration and workflow systems.

In response to this requirement, please provide the citation and a copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to providing a screen/interface for accessing both collaboration and workflow systems.

For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in

the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement.

Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this

Art Unit: 3624

requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's submission filed December 15, 2008. Applicant's submission amended claims 14-23, 34-37 and 39-46, canceled claim 38 and added new claim 47. Claims 1-13 and 24-33 being previously canceled. Currently Claims 14-23, 34-37 and 39-47 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2008 has been entered.

Response to Amendment

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Response to Arguments

4. Applicant's arguments with respect to claims 14-23, 34-37 and 39-46 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claims 14-23, 34-34 and 39-47 are objected to because of the following informalities. Appropriate correction is required.

Regarding Claim 14, Claim 14 recites that the actors "can collaborate in the collaboration system for the workflow" however it is noted that the actors do not actually collaborate for the workflow as currently claimed. For the purposes of examination the examiner assumes applicant will amend the claims to positively recite that the actors actually collaborate for the work flow.

Appropriate correction required.

Regarding Claim 37, claim 37 recites "any actor... can collaborate with any other actor" however it is noted that the actors do not actually collaborate with any other actors as the invention is currently claimed. For the purposes of examination examiner assumes applicant will amend the claims to recite that the actors actually collaborate with other actors.

Appropriate correction required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 14-23, 34-37 and 39-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14-23, 34-37 and 39-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 14-23, 34-37 and 39-47 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at

1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

It is noted that the recitation “A method *for implementation* by a computer” (Claim 1) nor “A method *implementable* by a computer” (Claim 37) have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14-23, 34-35 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 14, Claims 14 recites the limitation "said interface enabling" in Claims 14 wherein it is unclear which of the preceding interfaces Applicant's are intending to further limit (i.e. is it the interface to the workflow system or the interface to the collaboration system, both or another interface all together).

For the purposes of examination the phrase "said interface enabling" was interpreted to mean any one or both of the preceding interfaces. Appropriate correction required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 14-23, 34, 37 and 39-47 are rejected under 35 U.S.C. 102(a) as being anticipated by Estrada et al., U.S. Patent No. 6,594,664.

Regarding Claim 14 Estrada et al. teach a system and method comprising:

- in one screen (window, area, browser, user interface, page, display, monitor, etc.) providing both an interface (link, screen, API, etc.) to a workflow (process) system (software, application, software, sub-system, computer, etc.) for performing a selected workflow (intended use of the workflow system) and an interface to a collaboration system (Column 9, Lines 3-15; Column 12, Lines 12-39; Figures 5-6, 17, 29);
- an interface enabling information about a current instance of the selected workflow to pass between the workflow and collaboration systems such that actors of the current selected workflow instant can collaborate in the collaboration system for the workflow (Column 29, Lines 32-68; Column 31, Lines 1-22).

Regarding Claim 37 Estrada et al. teach a system and method comprising:

- in a same screen (window, area, user interface, display, etc.) providing both an interface to a workflow system for performing a selection workflow and an interface to a

Art Unit: 3624

collaboration system within which any actor of a current instance of a selected workflow can collaborate with any other actor of the instance (Column 9, Lines 3-15; Column 12, Lines 12-39; Figures 5-6, 17, 29);

- with the workflow system enabling the actors to be defined (Access Control Lists, Member Directory, LDAP; Column 16, Lines 14-52; Column 18, Lines 41-63; Column 20, Lines 11-21); and
- providing a list of the actors of a current instance of a selected workflow to the collaboration system (Access Control Lists, Member Directory, LDAP; Column 16, Lines 14-52; Column 18, Lines 41-6; approvers list; Column 29, Lines 45-59; Column 30, Lines 50-68).

Regarding Claims 15 and 39 Estrada et al. teach a system and method wherein the actors comprising at least one of the following workflow or external actors (Abstract; Column 29, Lines 50-68).

Regarding Claims 16 and 40 Estrada et al. teach a system and method further comprising notifying at least one workflow actor that a work item is waiting for him/her to act upon (Column 29, Lines 35-45; Column 30, Lines 30-33; Column 31, Lines 7-22).

Regarding Claims 17 and 41 Estrada et al. teach a system and method wherein notifying comprises producing a hyperlink to the awaiting work item (Column 29, Lines 35-45; Column 30, Lines 30-33; Column 31, Lines 7-22).

Regarding Claims 18 and 42 Estrada et al. teach a system and method further comprising accumulating correspondences of the actors when performance the selected workflow instance (Column 29, Lines 35-45; Column 30, Lines 30-33; Column 31, Lines 7-22).

Regarding Claims 19 and 43 Estrada et al. teach a system and method wherein accumulating further comprises sending a hyperlink to a location where a workflow actor may process a work item (Column 29, Lines 35-45; Column 30, Lines 30-33; Column 31, Lines 7-22).

Regarding Claims 20 and 44 Estrada et al. teach a system and method wherein accumulating comprises transferring control of a work item from a first workflow actor to a second workflow actor (Column 29, Lines 33-68; Column 30, Lines 50-68; Column 31, Lines 1-22).

Regarding Claim 21 Estrada et al. teach a system and method further comprising providing a contact (actor, buddy, user, etc.) list of at least some of the actors to the collaboration system (member list/directory, approval list, contacts; Column 18, Lines 42-55; Column 20, Lines 11-22; Column 29, Lines 50-68).

Regarding Claims 22 and 45 Estrada et al. teach a system and method further comprising activating a (staff resolution) component (software, subsystem, code, etc.) of the workflow system to determine the actors for the current workflow (Access Control Lists, Member Directory, LDAP; Column 12, Lines 13-32; Column 16, Lines 14-52; Column 18, Lines 41-6; approvers list; Column 29, Lines 45-59; Column 30, Lines 50-68; Figure 8).

Regarding Claims 23 and 46 Estrada et al. teach a system and method wherein activating further comprises selection a portion of the actors according to a current work item to be performed (Column 18, Lines 56-62; Column 29, Lines 46-68; Column 30, Lines 50-68).

Regarding Claim 34 Estrada et al. teach a system and method further comprising providing a support interface per support application which supports the performance of the selected workflow (Figures 10, 12-13, 28-29).

Regarding Claim 47 Estrada et al. teach a system and method further comprising (Access Control Lists, Member Directory, LDAP; Column 12, Lines 13-32; Column 16, Lines 14-52; Column 18, Lines 41-6; approvers list; Column 29, Lines 45-59; Column 30, Lines 50-68; Figure 8): receiving data of the current instance and a list of current actors from the workflow system; and providing the list to the collaboration system.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being obvious over Estrada et al., U.S. Patent No. 6,594,664 as applied to claims 14 and 37 above and further in view of official notice.

Regarding Claims 35-36 Estrada et al. does not expressly teach a system and method wherein the support interface includes a portlet as claimed.

Official notice is taken that utilizing one or more portlets to provide a single screen (interface, portal, web page, etc.) to a plurality of systems is old and very well known as evidenced by at least the following references:

- Fischer, WebSphere Portal, Portlets and Web Services (2002) – Pages 4, 11; Bullet 2, Page 25
- Schaeck, WebSphere Portal Server and Web Services Whitepaper (2001) – Page 3

It would have been obvious to one skilled in the art at the time of the invention that the system and method as taught by Estrada et al. would have benefited from

utilizing any of a plurality of well known technologies to construct the single interface/screen/page including but not limited to portlets in view of the teachings of official notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Belfiore et al., U.S. Patent No. 6,990,513, teach a system and method for providing an interface wherein a list of current actors is provided in a collaborative work space.

- Ouchi, U.S. Patent No. 7,289,966, teach a workflow system and method wherein a list of the current actors from the workflow system is provided and used to select which actor the workflow will pass control to as part of the workflow.

- Davies et al., U.S. Patent No. 7,359,938, teach a system and method for providing a list of actors available in the system who can be collaboration with any other actors.

- Beringer et al., U.S. Patent No. 7,403,899, teach a system and method for providing a single interface to a collaboration system (e.g. workspace, chat) and a workflow system.

- Ludwig et al., U.S. Patent No. 7,421,470, teach a system and method for providing a collaboration system to a plurality of actors.

- Navani et al., U.S. Patent No. 7,448,046, teach a collaborative workflow system and method.
- Wynn et al., U.S. Patent NO. 2004/0261013, teach a system and method comprising: in one screen providing an interface to both a workflow and a collaboration system the screen enabling information about a current workflow to pass between the workflow and collaboration systems.
- ActionWorkflow Enterprise Series 3.0 Process Builder User's Guide (1996), teaches a workflow system and method wherein the system/method provides a single screen/interface to both collaboration and workflow systems (subsystems/components).
- Teamware Flow 3.1 User's Guide (2000), teaches a workflow system and method.
- Rappaport, Instant Messaging For Corporate Collaboration (2001), teaches a system and method comprising workflow and collaboration system wherein users communicate during selected workflow instances regarding the workflow/performance of workflow tasks using an integrated instant messaging system. More specifically Rappaport teaches *"With instant messaging integrated with enterprise applications, employees can initiate real-time collaboration sessions as part of a company's workflow. Integration can also give users access to corporate content and data during a collaborative session. "Real-time collaboration is [typically] integrated into enterprise applications in transaction-oriented environments," says Shaw. "Collaboration in this context is used to solve a specific, short-term problem." When a problem crops up that can't be dealt with within the normal workflow, the system can call for a*

collaborative session among workers, with business partners or with a customer in order to solve the problem." (emphasis added, Paragraphs 6-7, Page 2).

Rappaport further teaches that "*Integrating with front-end interfaces, such as Web portals, is generally easier and less expensive than integrating into back-end applications. In the front-end approach, instant messaging tools are presented to users like any other online service. Sessions are initiated by users rather than by the workflow, and collaboration becomes project-oriented rather than event driven.*

Integrating collaboration into a common-user interface encourages users to take advantage of the technology because it's in front of them alongside other applications and services they use on a regular basis. Most vendors seem to agree that integration of instant messaging with portals is a good idea." (emphasis added, Paragraphs 1-2, Page 3).

- Schaeck, WebSphere Portal Server and Web Services Whitepaper (2001), teaches a system and method for providing a single screen (portal) which enables users to interface/access a plurality of systems wherein the single interface comprises a plurality of portlets (Figure on Page 3).

- Teamspace Web Pages (2000), teaches a system and method for supporting collaborative work via the Internet.

- Using Collaboration Task in ORBWORK Enactment System for Meteor Workflow Management System (2000), teaches a system and method for providing access to both collaboration and workflow systems.

- Geyer et al., A Team Collaboration Space Supporting Capture and Access of Virtual Meetings (2001), teaches a system and method for providing an interface to collaboration and workflow systems.

- Fischer, WebSphere Portal, Portlets and Web Services (2002), teaches a system and method comprising a single screen (portal) for accessing a plurality of systems, including but not limited to collaboration and workflow systems, via portlets.

- Bafoutsou et al., Review and functional classification of collaborative systems (2002), teaches a plurality of well known collaborative systems including workflow, chat, virtual workspaces, email, groupware and the like.

- New collaboration capabilities for WebSphere Portal Extend 4.2 (2002), teaches a system and method comprising a single interface (Collaboration Center) providing access to both collaboration and workflow systems and providing a list of contacts (actors) of the current instance of the workflow such that the actors can collaborate.

- IBM Beefs Up WebSphere Portal Collaboration (2003), teaches the public use and sale of a system and method for providing a single interface to a plurality of systems.

- Lotus.com – Sametime Web Pages (2001), teach the public sale of a collaboration system and method comprising a list of users, real-time collaboration and the like.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3624